

REMARKS/ARGUMENTS

Claims 13-45 are now pending and under examination. Applicant has amended claims 23, 24, 27, 29-31, 33, 34, 36, 37, 40 and 41 and rewritten claims 23, 24, 27, and 29 in independent form. No new matter has been added.

Support for Claim Amendment

The amendment of claim 13 is supported by the application as originally filed (see, for example, page 3, lines 1-6, of the English translation of the PCT specification).

Allowed and Allowable Claims

Applicant appreciates the Examiner's allowance of claims 32, 33, 35, 36, 39, and 40. Applicant also appreciates that the Examiner has indicated claims 17, 18, 23, 24, 27, and 29 would be allowable if they are rewritten to include all of the limitations of the base claim and any intervening claims. Claims 17 and 18 are in independent form. Claims 23, 24, 27, and 29 have been rewritten in independent form. Accordingly, claims 17, 18, 23, 24, 27, and 29 are in allowable form.

Minor Informalities

Claims 31, 33 and 36 were objected to for containing minor informalities. Applicant has amended the claims as suggested by the Examiner to overcome the objection.

Rejection under 35 U.S.C. §112, First Paragraph

Claims 30, 31, 34, 37, 38, and 41-43 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification as originally filed. Applicant has amended the claims as suggested by the Examiner to overcome the rejection.

Rejection under 35 U.S.C. §112, Second Paragraph

Claim 21 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action contended that there is no standard for determining the meaning of the limitation "immediate use." For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Applicant respectfully submits that the meaning of the limitation is clear to a person with ordinary skill in the art in view of the specification. In the specification, the term "immediate use" is always used in context of "immediate use" versus "storage in a tank." For example, at page 3, lines 31 and 32, the specification states "[t]he low-sulphur fuel obtained can either be utilized immediately or can be stored in a tank." Therefore, the description makes it clear that the term "immediate use" means that the low-sulphur fuel is used without being first stored in a tank. Additionally, there is no need to specify or determine the maximum time limit for "immediate use," because if the low-sulphur fuel is not stored before it is used, then the fuel must be fed to the engine as soon as it is produced.

Rejections under 35 U.S.C. §103(a)

Claims 13-16, 19-22, 25, and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bonville (U.S. Patent 6,156,084) in view of Miller (U.S. Patent 4,738,771). Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bonville in view of Miller and further in view of Lisieur (U.S. Patent 6,129,835). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections.

First, Applicant respectfully submits that the cited references do not teach or suggest all the claim limitations of the independent claim (claim 13). For example, claim 13 recites (1) the separation of sulfur-containing components

from engine fuel, as well as (2) the use of the low-sulfur fuel for a spark-ignition engine or a diesel engine. Bonville (the primary reference), on the other hand, only teach (1) the desulfurization of fuel for a fuel cell and (2) the use of the desulfurized fuel for a fuel cell. Accordingly, claims 13, as well as the dependent claims, are patentable over the cited references.

Second, Applicant respectfully submits that the Office Action has failed to provide the required suggestion or motivation to modify the reference or to combine reference teachings. Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103(a) requires, *inter alia*, consideration of whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed invention. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Applicant respectfully submits that the Office Action has failed to point out where in the prior art exists the suggestion to combine the teachings of the cited references, as required by *In re Dow Chemical Co.* Accordingly, claims 13, as well as the dependent claims, are patentable over the cited references.

Further, Applicant respectfully submits that the cited references actually teach away from combining the teachings of the cited references. In Bonville a fuel with a sulfur content of less than 0.05 ppm is used in order not to significantly affect the operation of the fuel cell assembly (see column 7, lines 45 to 50). In Miller, a sulfur content of approximately 0.2 ppm can be achieved (see column 4, line 57). In US 20020043484, only a sulfur content of 5 ppm is achieved (see table 2). (In addition, US 20020043484 is not prior art to the present application.) Therefore, the sulfur contents of Miller and US 20020043484 don't meet the requirement of Bonville. Accordingly, a person with ordinary skill in the art would not have modified the teaching of Bonville with the teachings of Miller and US 20020043484, as suggested by the Office Action, in order not to significantly affect the operation of the fuel cell assembly.

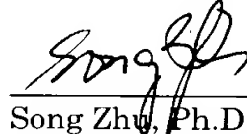
Appl. No. 09/806,465
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Reply to Office action of May 21, 2003

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #225/49816).

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